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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,109	06/15/2001	John J. Altavilla	FIS920000193US1	7735
7590	04/10/2006		EXAMINER	
George R. Pettit Connolly Bove Lodge & Hutz LLP P.O. Box 19088 Washington, DC 20036-3425			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/882,109

Applicant(s)

ALTAVILLA ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/27/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 - 5, 7, 9, 11, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5, 7, 9, 11, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1, 3 – 5, 7, 9, 11, 15 and 17 are presented for examination.

#### ***Priority***

2. The supposed Affidavits filed on 12/27/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fukumoto reference. Applicant's have not signed any Declarations or Affidavits in regards to the two Exhibits that the Attorney has submitted

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Fukumoto reference to either a constructive reduction to practice or an actual reduction to practice. Applicant and Attorney state that the date of Exhibit 4, May 4, 2001, and Exhibit 5, May 30, 2001, show communications between the parties involved which lead up to the filing of the application on June 15, 2001.

4. If the Exhibits of 1-3 where to predate February 13, 2001, which is Fukumoto's date, there is a more than a three month gap which no communication was received, February to May. Therefore, there are still insufficient showings of diligence in ALL Exhibits.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3 – 5, 7, 9, 11, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumoto et al. U.S Publication No. 2001/0051987 (hereinafter Fukumoto) in view of Rochkind U.S. Patent No. 6301608.

7. As per claim 1, as closely interpreted by the Examiner, Fukumoto teaches a process for identifying an attention level in an electronic mail text message being sent to multiple recipients comprising:

8. creating a list of addresses for said recipients, (e.g., ¶ 0048 – 0052);
9. identifying a specific portion of said text message to be highlighted for a specific address, (e.g., ¶ 0048 – 0052);
10. a tag identifying said specific highlighted portion, (e.g., ¶ 0048 – 0052);
11. sending said text message to each of said recipients which includes each of said addresses and the appended tags, (e.g., ¶ 0061 – 0065); and
12. displaying for each recipient said text message with an attention level indication in response to the tag associated with the recipients address and with said specific portion highlighted for said recipient having said specific address, (e.g., ¶ 0048 – 0052, 0071 – 0073).

Fukumoto does not explicitly teach appending to each of said addresses a tag representing an attention level for said recipients. Rochkind teaches appending to each of said addresses a tag representing an attention level for said recipients, (e.g., col. 6, lines 12 – 40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine

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Rochkind with Fukumoto because correlating a specific recipient's address with a section of a email message to be highlighted for their specific attention will give a specific recipient the ability to pay attention and identify at a glance, the important parts of the email that pertain to that specific recipient.

13. As per claim 3, Fukumoto does not specifically teach selecting said attention level from a table displayed on a user's display screen;

14. selecting an address from a table containing said address list;

15. attaching a tag representing said attention level to said selected address.

16. Rochkind teaches selecting said attention level from a table displayed on a user's display screen, (e.g., col. 6, lines 12 – 40);

17. selecting an address from a table containing said address list, (e.g., col. 6, lines 12 – 40);

18. attaching a tag representing said attention level to said selected address, (e.g., col. 6, lines 12 – 40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because of similar reasons stated above and furthermore it is well known in the art that utilizing a graphical user interface (GUI) is visually more convenient for a user to initiate commands as in a web page or Windows type system than a non-GUI system that would require specific commands to carry out tasks such as DOS or Unix.

19. As per claim 4, Fukumoto does not specifically teach attaching a tag representing a default attention level when an attention level is not specified for an address.

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20. Rochkind teaches attaching a tag representing a default attention level when an attention level is not specified for an address, (e.g. col. 6, lines 33 – 46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because it would be more convenient for a user to not have to always select an attention level if there is nothing to draw the user's attention to.

21. As per claim 5, Fukumoto does not specifically teach ordering each message to be displayed by a recipient according to said attention level. Rochkind teaches ordering each message to be displayed by a recipient according to said attention level, (e.g. Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because it would be more efficient for a user to view the emails that are most important to them first then emails that are less important or have no importance at all.

22. Claims 7, 9, 11, 15 and 17 are rejected for similar reasons as stated above.

### ***Response to Arguments***

23. Applicant's arguments filed 12/27/2005 have been fully considered but they are not persuasive.

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24. In the Remarks, Applicant argues in substance that Fukumoto does not disclose or teach appending to each of said addresses a tag representing an attention level for said recipients and a tag identifying said specific highlighted portion for each recipient.

25. As to part 1, Examiner would like to draw the Applicant's attention to the above rejection. In which one can see that Fukumoto was not relied upon for teaching said limitation, Rochkind was the indented reference.

26. In the Remarks, Applicant argues in substance that Fukumoto nowhere discloses "determining from a tag inserted in an address field of said message whether any portion of said message is highlighted," as recited in claim 9, "displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee" as recited in claims 11 and 15; and "determining from a tag inserted in a field of said message whether any portion of said message is highlighted," as recited in claim 17.

27. As to part 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

28. In the Remarks, Applicant argues in substance that Rochkind nowhere discloses "a tag identifying said specific highlighted portion for each recipient," as recited in claim 1; "determining from a tag inserted in an address field of said message whether any portion of said message is highlighted," as recited in claim 9, "displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee," as

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recited in claims 11 and 15; and "determining from a tag inserted in a field of said message whether any portion of said message is highlighted," as recited in claim 17.

29. As to part 3, Examiner would like to draw the Applicant's attention to the rejection stated above, in which one can see that Rochkind was not relied upon to teach the limitations of "a tag identifying said specific highlighted portion for each recipient." Furthermore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

30. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

31. In the Remarks, Applicant argues in substance that Applicant submitted new Exhibits stating the diligence is shown and that Fukumoto is no longer prior art.

32. As to part 4, Examiner would like to draw the Applicant's attention to the above statement regarding the Affidavits.

### ***Conclusion***



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

DE



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100